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ZIOLKOWSKI PATENT SOLUTIONS GROUP, SC (GEMS)			SIMITOSKI, MICHAEL J	
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MEQUON, WI 53097			ART UNIT	PAPER NUMBER
			2134	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,561

Applicant(s)

DURBIN ET AL.

Examiner

Michael J. Simitoski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The responses of 11/17/2005 were received and considered.
2. Claims 1-29 are pending.

Response to Arguments

3. As an initial matter, a response to the previous Office Action was received from Robert J. Brill and a supplemental response was received from Timothy J. Ziolkowski. As it is not standard practice to engage in correspondence with multiple representatives, it is unclear if the responses are to be taken together. For the purpose of advancing prosecution, the received correspondence will be treated as a unified response.
4. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.
5. In light of Applicant's amendments to claim 24, the rejection of claims 24-26 under 35 U.S.C. §112 ¶2, set forth in the previous Office Action, is withdrawn.
6. Applicant's response (pp. 7-9) argues that despite the Interim Guidelines for Examination of Patent Application for Patent Subject Matter Eligibility's statement that "such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of §101", the rejection under §101 should be withdrawn because the limitations of claim 17 recite more than physical characteristics of a form of energy, but create a functional interrelationship with a computer. Claim 17 recites that when executed by a processor, the signal causes at least one processor to perform steps. However, applicant has failed to address which statutory class of invention under which claim 17 falls. Therefore, it is maintained that the

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claimed subject matter is not eligible subject matter for patent protection under the four statutory classes under §101, as suggested by the interim guidelines.

7. Applicant's response (p. 16, and pp. 7-9 of the supplemental response) requests a production of authority for the stated Official Notice. Further, Applicant's supplemental response (p. 7) argues that the Examiner is taking "Official Notice of an entire element of the claims, thereby effectively attempting to fill in apparent "holes" in the rejection rather than "gaps"". First, the portion of the MPEP recited by applicant has omitted certain text from the MPEP. For instance, the judicial application and rarity of application apply to the Examiner taking official notice *without* documentary evidence. However, as stated below, documentary evidence was supplied. Furthermore, the MPEP states the following:

In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without the support of documentary evidence provided the facts so noticed are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the examiner to support a particular ground of rejection.

Again, this applies to a *lack* of documentary evidence, which was not the case in the previous Office Action. The Examiner is only using common knowledge in the art as to the specific motivation one of ordinary skill would have had for using the prior art method of emailing an activation code (Fenstermaker) in combination with the Steinmetz invention.

Steinmetz discloses that the authorization key can be manually entered into the ATM by a service employee (col. 9, lines 12-30), but lacks how the service employee receives the key. Fenstermaker is cited to teach the "entire element" of the claim, mainly receiving an alphanumeric key via email, which, when entered into an ultrasound machine, enables a selected

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feature. As stated in the Office Action, the prior art teaches this feature. The Examiner took official notice because while Fenstermaker discloses the feature of communication of a software activation key via email, no explicit motivation for doing so is provided. However, the Examiner's position is such that the benefits of email communication were well known at the time of the invention to include avoiding the need for paper mail. Applicant argues that the instant "application was filed January 18, 2002". In response, the cited dictionary definition of e-mail states that the use of the word "e-mail" for an electronic message was in the year 2000 well established (p. 1). The reference to Microsoft (1997) is cited for teaching the definition of email. U.S. Patent 5,893,099 to Schreiber et al. (filed 1997) is cited for teaching that "electronic mail (e-mail) is developing into a preferred alternative to the telephone, conventional paper mail service and facsimile transmission as a means to communicate" (col. 1, lines 30-33). Pre-grant publication 2002/0129275 to Decuir (file 2001) is cited for teaching that "e-mail has revolutionized the way people communicate" and that email is much faster than traditional postal mail (§4). The above evidence is cited to teach that e-mail was well known to be faster and more accessible than traditional methods of data transfer, such as manually via postal mail, at the time the invention was made. Further, U.S. Patent Application Publications 2002/0090934 (Mitchelmore, filed 2001, ¶103) and 2003/0013434 (Rosenberg et al., filed 2001, ¶72) and U.S. Patent 6,738,760 (Krachman, filed 2000, col. 7, lines 34-39) are all cited for teaching that it was, at the time the invention was made, well known to communicate a code via email to a user. In each of these references, the explicit purpose of the code in the email is to enable previously disabled software or software features. Therefore, it is maintained that one of ordinary skill in the art would have been motivated to send the activation code of Steinmetz to the user via email

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as both emailing activation codes was publicly known and email itself has notorious benefits over manual systems such as the postal mail.

Applicant's response (p. 8, supplemental response) argues that nothing in Fenstemaker leads one to believe that the conveyance is automatic. However, no definition of "automatic" is given in the specification. The dictionary.com definitions are as follows:

“Acting or operating in a manner essentially independent of external influence or control: an automatic light switch; a budget deficit that triggered automatic spending cuts.

Self-regulating: an automatic washing machine.

Acting or done without volition or conscious control; involuntary: automatic shrinking of the pupils of the eyes in strong light. See Synonyms at spontaneous.

Acting or done as if by machine; mechanical: an automatic reply to a familiar question.”

Using the above definitions, “automatic” would be interpreted as happening without external influence. However, on pp. 7-8 of the instant specification, the sending of the key via an electronic messaging system is in response to at least the user accepting a contract and is therefore not without external influence. In Fenstemaker, the key is given to the user as a result of ordering a feature or ordering a medical device (col. 2, line 65 – col. 3, line 2). The authorization key is created by a machine at the license authority and is required to be given to a user to enable the applications and Steinmetz discloses no need for intervening processes. Applicant is requested to clarify the definition of “automatically” and identify the corresponding portion of the specification that explicitly differentiates the prior art from the claimed invention.

Specification

8. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the

following is required: The specification does not disclose automatically accepting a verification email from the user verifying self-activation of the disabled option.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a computer data signal, which does not fall within one of the four statutory classes of invention under §101.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose automatically accepting a verification email from the user verifying self-activation of the disabled option.

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Regarding claim 1, it is unclear whether the providing is done remotely or the user is remote.
- b. Regarding claim 10, it is unclear how the user can input an alphanumeric code on the data entry module of the stand-alone device if the user is remote from the device.
- c. Regarding claim 17, it is unclear whether the user or the receiving step are “remote from the centralized facility and the remote stand-alone device”.
- d. Regarding claim 22, it is unclear how the user can input an alphanumeric code on the data entry module of the stand-alone device if the user is remote from the device.
- e. Regarding claims 1, 10, 17 & 22, it is unclear how the “user” of the medical device is defined; the user is usually defined as the person using the device, however, in this situation, the user is remote from the device and not using it.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 10-12, 17-19, 22-24 & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,672,505 to Steinmetz et al. (**Steinmetz**) and U.S. Patent 6,584,309 to **Whigham**.

Regarding claims 10-12 & 17-18, Steinmetz discloses instructions to receive, at a centralized facility/licensing authority (col. 9, lines 31-34), a request to activate an option/configuration (col. 9, lines 31-34) resident in memory of a remote stand-alone device/ATM from a user (col. 16, lines 9-18) remote from the centralized facility/licensing authority (col. 9, lines 54-64), determine whether the user is qualified (has paid) (col. 16, lines 9-18) and if so, grant access to the option resident in the remote stand-alone device (col. 9, lines 62-64) for a limited time period (col. 10, line 61 – col. 11, line 2), generate a software key/authorization key designed to allow access to the option for the limited time period (col. 9, lines 31-44 & col. 10, line 61 – col. 11, line 2) and send the software key to the user (col. 9, lines 11-30). Steinmetz lacks the user being remote from the centralized facility and the remote stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to allow the user to be remote from the centralized facility and the remote stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection

between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

Regarding claim 19, Steinmetz discloses receiving a user identifier/Customer ID, receiving a system identifier/Terminal ID and receiving an option identifier/Configuration ID (Fig. 5) and to generate the software key to be specific to the user, the system and the option (col. 10, line 57 – col. 11, line 8).

Regarding claims 22-23, Steinmetz discloses a graphical user interface configured to facilitate user activation of a disabled option resident on a device (Fig. 5), receive a number of user inputs from a user remote from the device (licensing authority receives requests) (col. 9, lines 33-34 & col. 10, lines 57-62), generate an alphanumeric code/authorization key configured to activate the disabled option upon user inputting of the alphanumeric code/authorization key on a data entry module/keyboard of the device (col. 5, lines 14-25) and automatically convey the alphanumeric code to the user (col. 11, line 66 – col. 12, line 1). Steinmetz lacks the user being remote from the centralized facility and the remote stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to allow the user to be remote from the centralized facility and the remote stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate

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the need for a dedicated online connection between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

Regarding claim 24, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing a time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2).

Regarding claim 26, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing a time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2), but lacks the period of delay being 24 hours. However, absent any showing of criticality, it would have been obvious to choose the expiration period to be 24 hours.

17. Claims 20 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz** and **Whigham**, as applied to claim 17 above, in further view of U.S. Patent 6,490,684 to Fenstemaker et al. (**Fenstemaker**). Steinmetz discloses an encrypted alphanumeric identifier (col. 5, lines 57-59), but lacks the device being a medical imaging scanner. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

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18. Claims 1-5, 7-12, 16-18 & 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,301,666 to **Rive, Whigham and Fenstermaker**.

Regarding claims 1, 4-5, 7, 10, 12 & 16-18, Rive discloses receiving a request and I.D. data from a user of a remotely located stand-alone device/client (col. 16, lines 44-49 & col. 17, lines 32-36) seeking access to a non-enabled option resident on the device (col. 17, lines 37-43), generating an electronic enabler/one-time password configured to enable the non-enabled option, transmitting the electronic enabler to the user and providing instructions to the user to install the electronic enabler/one-time password in the remotely located stand-alone device to activate the option on the remotely located stand-alone device (col. 17, lines 48-55). Rive lacks the user being remote from the centralized facility and the remote stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to send the instructions and an electronic enabler to the user's phone, remote from the stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47). Rive, as modified above, lacks the device being a medical imaging device. However, Fenstermaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstermaker (col. 1, lines 21-32).

Regarding claim 2, Rive discloses enabling access for a predetermined period of time/renting (col. 16, lines 37-41 & lines 62-67).

Regarding claim 3, Rive explicitly lacks renting the option for a trial period of thirty days. However, the examiner takes Official Notice that renting an item for thirty days is old and well established in the art of renting/leasing as a method of allowing a user to access an option for one month. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to rent the option specifically for thirty days. One of ordinary skill in the art would have been motivated to perform such a modification to engage in a monthly subscription. This advantage is well known to those skilled in the art.

Regarding claim 8, Rive discloses generating the electronic enabler upon user satisfaction of a user account/profile (col. 16, lines 43-46).

Regarding claim 9, Rive discloses a centralized facility/supplier (col. 17, lines 38-44) by a user at a workstation remote from the centralized facility, but lacks explicitly a graphical user interface. However, Rive discloses that the request can be sent via email or web (col. 17, lines 33-37), and it is held that both email and web based communication require a graphical user interface. Further, Rive, in combination with Whigham, discloses forming a request via a cell phone/graphical user interface.

Regarding claim 11, Rive discloses emailing the alphanumeric code/password (col. 17, lines 49-55).

Regarding claims 20-21, Rive, as modified above, lacks the alphanumeric code being encrypted. However, Fenstemaker teaches that encrypting an authorization key reduces the likelihood of unauthorized use of a feature/option (col. 5, lines 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to encrypt the software key. One of ordinary skill in the art would have been motivated to perform such a modification to reducing reduce the likelihood of unauthorized use of a feature/option, as taught by Fenstemaker (col. 5, lines 1-3).

19. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham and Fenstemaker**, as applied to claim 12 above, in further view of U.S. Patent Application Publication 2002/0124168 to Mccown et al. (**Mccown**). Rive, as modified, discloses a medical imaging scanner (Fenstemaker, col. 1, lines 21-32), but lacks explicitly disabling the activated option upon expiration of the predetermined and limited time. However, Mccown teaches that one method of licensing components on a computer is to lease a component, wherein when a lease is expired the options on the device are disabled/unstrapped (§43) to inexpensively upgrade a computing environment (§6). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to disable the activated option upon expiration of the predetermined and limited time/lease expiration. One of ordinary skill in the art would have been motivated to perform such a modification to inexpensively upgrade a computing environment, as taught by Mccown (§6 & §43).

20. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham and Fenstermaker**, as applied to claim 10 above, in further view of **Steinmetz**. Rive lacks prompting the user to input a user identifier, a system identifier, a stand-alone identifier and a disabled option identifier, generate an electronic license contract and prompt the user to either accept or decline the license contract. However, Steinmetz teaches a user entering a user identifier/Customer ID, a system identifier/Terminal ID (Fig. 5), a stand-alone device identifier/Processor ID (col. 5, lines 26-35) and a disabled option identifier/Configuration ID (Fig. 5) and prompting the user to accept the license terms before enabling the ATM to be configured (col. 13, lines 55-62). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to input a set of data, generate an electronic license contract and prompt the user to either accept or decline the license contract. One of ordinary skill in the art would have been motivated to perform such a modification to compare configuration data to verify the activation key and to enable the ATM according to a license agreement, as taught by Steinmetz (col. 3, lines 23-27, col. 4, lines 29-41, col. 5, lines 26-35, col. 13, lines 55-62 & Fig. 5).

21. Claim 6 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham and Fenstermaker**, as applied to claims 1 & 10 above, in further view of “Something for Nothing – Phone for free, save on books, or build a home page on the house. The Web offers an abundance of free stuff-but watch out for strings” by **Castagna**. Rive, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However,

Castagna teaches that demoware is a limited version of a commercial vendor's application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2).

22. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz** and **Whigham**, as applied to claim 24 above, in view of **Castagna** and U.S. Patent Application Publication 2002/0078177 to **Dutta**. Steinmetz, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor's application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2). As modified, Steinmetz performing the emailing specifically upon expiration of the period of delay. However, Dutta teaches that to entice a user to buy a subscription, a merchant can contact a user when a trial subscription ends in hopes the user will purchase a subscription (¶7). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to send the email upon the expiration of the period of delay. One of ordinary skill in the art would have been motivated to perform such a modification to entice a user to buy a subscription, as taught by Dutta (¶7).

23. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham, and Fenstermaker**, as applied to claim 1 above, in view of U.S. Patent 5,708,709 to **Rose**. Rive, as modified above, lacks conveying a follow up message to the user prior to an expiration of a trial period for which the user is enabled access. However, Rose teaches that a soft expiration date, where the user is warned that at the a future termination date, the user will need to obtain a licensed copy of an application program (col. 11, lines 16-23), avoids suddenly preventing use of the application and ensures the user is warned of expiration (col. 11, lines 23-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to convey a follow up message to the user prior to the expiration of a trial period. One of ordinary skill in the art would have been motivated to perform such a modification to avoid suddenly preventing use of the application and ensure the user is warned of expiration, as taught by Rose (col. 11, lines 16-34).

24. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz, Whigham, Castagna and Dutta**, as applied to claim 25 above, in view of U.S. Patent 6,795,703 to Takae et al. (**Takae**). Steinmetz, as modified above, lacks further causing the computer/licensing authority to automatically accept a verification email from the user verifying self-activation of the disabled option. However, Takae teaches that if a verification email is

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accepted from a user who has just activated a handset, the verifier is assured that the activation was successful without visiting a particular location (col. 5, lines 5-25 & lines 42-49).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz's licensing authority to automatically accept a verification email from the user verifying self-activation. One of ordinary skill in the art would have been motivated to perform such a modification to inform the licensing authority that the activation was successful without visiting a particular location, as taught by Takae (col. 5, lines 5-25 & lines 42-49).

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m.. The examiner can also be reached on alternate Fridays from 6:45 a.m. - 3:15 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached at (571) 272-3838.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300
(for formal communications intended for entry)

Or:

(571) 273-3841 (Examiner's fax, for informal or draft communications, please label "PROPOSED" or "DRAFT")

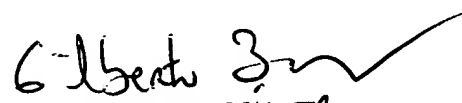
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MJS

February 9, 2006



GILBERTO BARRON JR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100